

REMARKS

Applicants thank the Examiner for the thorough examination given the present application.

Status of the Claims

Claims 1 and 3 are pending in the above-identified application. Claim 1 has been amended. Support for the recitations in claim 1 can be found in the present specification, *inter alia*, at paragraph [0027]. Thus, no new matter has been added.

Applicants submit that the present Amendment reduces the number of issues under consideration and places the case in condition for allowance. Alternatively, entry of the present amendment is proper to place the claims in better form for appeal.

In view of the following remarks, Applicants respectfully request that the Examiner withdraw all rejections and allow the currently pending claims.

Issues under 35 U.S.C. § 103(a)

1) Claims 1 and 3 are rejected under 35 U.S.C. § 103(a) as being unpatentable over Jakobson et al. '719 (US 5,446,719) in view of JP '654 (JP 2001-025654) and Akiyama et al. '357 (US 5,399,357).

2) Claims 1 and 3 are rejected under 35 U.S.C. § 103(a) as being unpatentable over JP '456 (JP 2003-012456) in view of Jakobson et al. '719, Akiyama et al. '357, and JP '654.

3) Claims 1 and 3 are rejected under 35 U.S.C. § 103(a) as being unpatentable over JP '654 in view of Akiyama et al. '357.

Applicants respectfully traverse. Reconsideration and withdrawal of these rejections are respectfully requested based on the following considerations.

Legal Standard for Determining Prima Facie Obviousness

MPEP 2141 sets forth the guidelines in determining obviousness. First, the Examiner has to take into account the factual inquiries set forth in *Graham v. John Deere*, 383 U.S. 1, 17, 148 USPQ 459, 467 (1966), which has provided the controlling framework for an obviousness analysis. The four *Graham* factors are:

- (a) determining the scope and content of the prior art;
- (b) ascertaining the differences between the prior art and the claims in issue;
- (c) resolving the level of ordinary skill in the pertinent art; and
- (d) evaluating any evidence of secondary considerations.

Graham v. John Deere, 383 U.S. 1, 17, 148 USPQ 459, 467 (1966).

Second, the Examiner has to provide some rationale for determining obviousness. MPEP 2143 sets forth some rationales that were established in the recent decision of *KSR International Co. v. Teleflex Inc.*, 82 USPQ2d 1385 (U.S. 2007).

As the MPEP directs, all claim limitations must be considered in view of the cited prior art in order to establish a *prima facie* case of obviousness. See MPEP 2143.03.

Distinctions over the Cited References

As the Examiner admits, Jakobson et al. '719, JP '654, and JP '456 fail to disclose a polyglycerol selected from the group consisting of pentadecaglycerol and eicosaglycerol. The Examiner relies on Akiyama et al. '357 in an attempt to supplement this deficiency. However, Applicants respectfully submit that the Akiyama et al. '357 reference is not properly combinable with the other cited references. Specifically, although Akiyama et al. '357 disclose that a fatty acid ester of a polyglycerol is formed by the combination of polyglycerol with a fatty acid, Akiyama et al. '357 relate to sustained release preparations for drugs rather than a cleansing cosmetic. As such, one of ordinary skill in the art would not turn to Akiyama et al. '357, relating to sustained release preparations, when pursuing a cleansing cosmetic. In other words, Akiyama et al. '357 is non-analogous art.

The Federal Circuit recently issued a decision regarding analogous art in *Innovation Toys LLC v. MGA Entertainment Inc.*, 98 USPQ2d 1013 (Fed. Cir. March 21, 2011). In *Innovation*, 98 USPQ2d at 1018, the Court stated:

A reference qualifies as prior art for a determination under § 103 when it is analogous to the claimed invention. *In re Clay*, 966 F.2d 656, 658 [23 USPQ2d 1058] (Fed. Cir. 1992). "Two separate tests define the scope of analogous art: (1) whether the art is from the same field of endeavor, regardless of the problem addressed, and (2) if the reference is not within the field of the inventor's endeavor, whether the reference still is reasonably pertinent to the particular problem with which the inventor is involved." *In re Bigio*, 381 F.3d 1320, 1325

[72 USPQ2d 1209] (Fed. Cir. 2004). “A reference is reasonably pertinent if ... it is one which, because of the matter with which it deals, logically would have commended itself to an inventor's attention in considering his problem.” *Clay*, 966 F.2d at 659. “If a reference disclosure has the same purpose as the claimed invention, the reference relates to the same problem, and that fact supports use of that reference in an obviousness rejection.” *Id.*

Turning to the first test noted above, the Akiyama et al. ‘357 reference is not from the same field of endeavor as the present invention or the cited references. Specifically, Akiyama et al. ‘357 relate to sustained release preparations for drugs rather than a cleansing cosmetic. Turning to the second test, the Akiyama et al. ‘357 reference is also not reasonably pertinent to the particular problem with which the inventor is involved. On page 6 of the outstanding Office Action, the Examiner asserts, “Akiyama et al. teach that using either pentadecaglycerol or eicosaglycerol to form polyglycerol fatty acid esters was known.” However, due to the specific application of Akiyama et al. ‘357 to sustained release preparations for drugs, Akiyama et al. ‘357 would not have logically commended itself to the inventors’ attention. In this regard, the disclosure of pentadecaglycerol and eicosaglycerol in Akiyama et al. ‘357 does not have the same purpose or relate to the same problem as the present invention. Therefore, the Akiyama et al. ‘357 reference is non-analogous art that should not be used in the outstanding obviousness rejections.

In response to the arguments above, the Examiner asserts:

This argument is not found persuasive because Akiyama et al. is used as an evidentiary reference in order to show that pentadecaglycerol and eicosaglycerol were known polyglycerols at the time of the instant invention and that both of said glycerols were known to be capable of undergoing esterification with fatty acids. Jakobson et al. teach that an object of the invention is to provide polyglycerol fatty acid esters. Jakobson et al. also teach that polyglycerols in general are esterified with fatty acid esters to produce polyglycerol fatty acid esters.

Applicants still respectfully submit that one of ordinary skill in the art would not turn to Akiyama et al. ‘357 to find specific polyglycerols for a cleansing cosmetic. Furthermore, one of ordinary skill in the art would have no reason or rationale to believe that a polyglycerol for sustained release preparations for drugs would be effective for use as a cleansing cosmetic. The Examiner fails to address these two issues.

In addition, the cited references disclose a maximum content of oil agent as being 60 wt% (Jakobson et al. '719, col. 5, lines 11-12). In contrast, claim 1 requires that "the oil agent is present in an amount of 70 to 99.8% by weight."

In response to this argument, the Examiner asserts that Jakobson et al. '719 disclose a content of oil agent as being 10-60 wt% and also disclose a content of 10-60 wt% polyglycerol, which is considered an oil component. Thus, the Examiner finds the sum of these two ingredients to meet the amounts of the "oil agent" in claim 1.

As amended, independent claim 1 specifically defines the oil agent, which excludes polyglycerols as an oil agent. Thus, Jakobson et al. '719 disclose a maximum content of the claimed oil agent as being 60 wt%.

To show that the content of 70% by weight provides unexpectedly superior results over a content of 60% by weight, Applicants previously provided a 37 CFR § 1.132 Declaration of Koki Takahashi. The Examiner is respectfully requested to review the previously provided Declaration of Koki Takahashi again as it provides strong evidence of the patentability of the present invention.

In the previously submitted Declaration, additional test data were set forth. Specifically, Example 3 of the present specification was prepared along with two other examples. In the first example, the oil content of Example 3 was changed from 80% to 70% to provide the lower limit of the claimed range. In the second example, the oil content of Example 3 was changed from 80% to 60% to provide the upper limit disclosed by the cited references. As shown in Table II of the previously submitted Declaration and reproduced below for the Examiner's convenience, the present invention is unexpectedly superior in terms of affinity to makeup soils, remover capability, and overall feel of use. The comparative example strongly evidences that the prior art does not produce the results of the present invention.

Table II (Functional Evaluation Results for Makeup Remover)

Raw Materials		Content (% by weight)		
		Ex. 3 (Oil Content: 80%)	Ex. 3-Rev. 1 (Oil Content: 70%)	Ex. 3-Rev. 2 (Oil Content: 60%)
Affinity to Makeup Soils	Dry state	●●	●	△
	Wet state	●	●	△
Rinsability	Dry state	●	●	○
	Wet state	●	○	○
Remover Capability	Dry state	●●	●	△
	Wet state	●	●	△
Overall Feel of Use		Score: 4.8	Score: 4.4	Score: 3.4
Formation of Microemulsion		○	○	△

As stated in the outstanding Office Action, the Examiner does not find the data persuasive and “is unimpressed with the confidence level of the submitted data in light of the fact that only 5 people made up the panel to give their opinion on subjective properties.” The Examiner also asserts that the difference in affinity to makeup soils and remover capability would be expected due to the higher oil agent content.

In response, Applicants respectfully assert that the panel consisted of five specialists rather than typical consumers. As such, their opinion on “subjective” properties deserves more weight than the Examiner suggests. With respect to the difference in affinity to makeup soils and remover capability being expected, Applicants respectfully submit that this assertion is based on hindsight. If such difference is expected, then one of ordinary skill in the art would also expect that a higher oil agent content is suitable, but the cited references do not disclose such a higher oil agent content.

Finally, although the Examiner states that the arguments filed on June 6, 2011 have been considered, the Examiner does not appear to address the arguments related to the Experimental Report provided in the Supplemental Response.

In this regard, with specific respect to Jakobson et al. '719, Applicants previously submitted an Experimental Report and English translation thereof, which provided results of follow-up tests on Example VII of Jakobson et al. '719. This Experimental Report was provided to the Japanese Patent Office in a corresponding Japanese application. The Examiner is respectfully requested to review the enclosed Experimental Report as it provides strong evidence of the patentability of the present invention.

In the Experimental Report, Cited Reference 1 refers to JP-A-Hei-6-192065, which corresponds to Jakobson et al. '719. The Experimental Report concludes:

A composition prepared in accordance with Example VII of Cited Reference 1 (Comparative Example 7) became white turbid when mixed with an equivalent volume of water. In addition, it was found that when a composition as prescribed in Example 3 of the present application prepared with this emulsifying agent was mixed with water, it became white turbid. It is indicated by the matter where the composition does not become transparent when mixed with water that microemulsions are not formed. Therefore, it is evident that the technology of the present application is not accomplished unless the polyglycerol moiety of the polyglycerol middle-chained fatty acid ester has a degree of polymerization satisfying the range defined in the present application. It is considered from the above that the present application and the technology described in Cited Reference 1 are clearly distinguishable from each other.

Thus, due to the unexpected results as achieved by the present invention, the rejection in view of Jakobson et al. '719 has been overcome. Reconsideration and withdrawal of this rejection are respectfully requested.

To establish a *prima facie* case of obviousness of a claimed invention, all of the claim limitations must be disclosed by the cited references. As discussed above, the cited references fail to disclose all of the claim limitations of independent claim 1, and claim 3 dependent thereon. Accordingly, the combinations of references do not render the present invention obvious.

Furthermore, the cited references or the knowledge in the art provide no reason or rationale that would allow one of ordinary skill in the art to arrive at the present invention as claimed. Therefore, a *prima facie* case of obviousness has not been established, and withdrawal of the outstanding rejections is respectfully requested. Any contentions of the USPTO to the contrary must be reconsidered at present.

Should the Examiner continue to assert that a *prima facie* case of obviousness has been established, Applicants respectfully submit that the rejections have been overcome due to the unexpectedly superior results achieved by the present invention. As stated in *KSR International Co. v. Teleflex Inc.*, 82 USPQ2d 1385, 1396 (2007), “rejections on obviousness cannot be sustained by mere conclusory statements; instead, there must be some articulated reasoning with some rational underpinning to support the legal conclusion of obviousness.” Furthermore, the mere fact that references *can* be combined or modified does not render the resultant combination obvious unless the results would have been predictable to one of ordinary skill in the art. *Id.* As described above, Applicants have shown that the present invention achieves unexpected and unpredictable results. Thus, reconsideration and withdrawal of the rejections for this alternative reason are respectfully requested.

Conclusion

All of the stated grounds of rejection have been properly traversed, accommodated, or rendered moot. Applicants therefore respectfully request that the Examiner reconsider all presently outstanding rejections and that they be withdrawn. It is believed that a full and complete response has been made to the outstanding Office Action, and as such, the present application is in condition for allowance.

Should there be any outstanding matters that need to be resolved in the present application, the Examiner is respectfully requested to contact Chad M. Rink, Registration No. 58,258, at the telephone number of the undersigned below to conduct an interview in an effort to expedite prosecution in connection with the present application.

If necessary, the Director is hereby authorized in this, concurrent, and future replies to charge any fees required during the pendency of the above-identified application or credit any overpayment to Deposit Account No. 02-2448.

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Respectfully submitted,

By 

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